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APPLICATION NO.	F	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/739,355	739,355 12/17/2003		Darii Paul Bolognesi	7872-109-999	1617
20583	7590	09/26/2006		EXAMINER	
JONES DA			PARKIN, JEFFREY S		
222 EAST 41ST ST NEW YORK, NY 10017			ART UNIT	PAPER NUMBER	
	,			1648	
				DATE MAILED: 09/26/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)				
	10/739,355	BOLOGNESI ET AL.				
Office Action Summary	Examiner	Art Unit				
	Jeffrey S. Parkin, Ph.D.	1648				
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply						
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>01</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).						
Status						
Responsive to communication(s) filed on <u>17 December</u> This action is FINAL . 2b) ☐ This Since this application is in condition for allower closed in accordance with the practice under E	action is non-final. nce except for formal matters, pro					
Disposition of Claims						
4) ⊠ Claim(s) <u>1-15</u> is/are pending in the application. 4a) Of the above claim(s) is/are withdray 5) □ Claim(s) is/are allowed. 6) □ Claim(s) is/are rejected. 7) □ Claim(s) is/are objected to. 8) ⊠ Claim(s) <u>1-15</u> are subject to restriction and/or expressions.	wn from consideration.					
Application Papers						
9) The specification is objected to by the Examine 10) The drawing(s) filed on is/are: a) accomposed and any objection to the Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the Examine	epted or b) objected to by the Eddrawing(s) be held in abeyance. See ion is required if the drawing(s) is obj	e 37 CFR 1.85(a). ected to. See 37 CFR 1.121(d).				
Priority under 35 U.S.C. § 119						
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 						
Attachment(s)						
 Notice of References Cited (PTO-892) Notice of Draftsperson's Patent Drawing Review (PTO-948) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 	4) Interview Summary Paper No(s)/Mail Da 5) Notice of Informal P 6) Other:	ite				

Serial No.: 10/739,355 Docket No.: 7872-109-999
Applicants: Bolognesi, D. P., et al. Filing Date: 12/17/2003

Restriction Requirement

35 U.S.C. § 121

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- a. Group I, claim(s) 1-3, drawn to human immunodeficiency virus type 1 and 2 (HIV-1/-2) peptides, classified in class 424, subclass 208.1.
- b. Group II, claim(s) 1, 2, and 4, drawn to respiratory syncytial virus peptides, classified in class 424, subclass 211.1.
- c. Group III, claim(s) 1, 2, and 5, drawn to human parainfluenza virus peptides, classified in class 424, subclass 211.1.
- d. Group IV, claim(s) 1, 2, and 6, drawn to influenza virus peptides, classified in class 424, subclass 211.1.
- e. Group V, claim(s) 1, 2, and 7, drawn to **hepatitis B virus** peptides, classified in class 424, subclass 227.1.
- f. Group VI, claim(s) 1, 2, and 8, drawn to Epstein-Barr virus peptides, classified in class 424, subclass 230.1.
- g. Group VII, claim(s) 9 and 10, drawn to a method for inhibiting HIV-1 or -2 cell fusion, classified in class 435, subclass 5.
- h. Group VIII, claim(s) 9 and 11, drawn to a method for inhibiting respiratory syncytial virus cell fusion, classified in class 435, subclass 5.
- i. Group IX, claim(s) 9 and 12, drawn to a method for inhibiting human parainfluenza virus cell fusion, classified in class 435, subclass 5.
- j. Group X, claim(s) 9 and 13, drawn to a method for inhibiting influenza virus cell fusion, classified in class 435, subclass 5.
- k. Group XI, claim(s) 9 and 14, drawn to a method for inhibiting
 hepatitis B virus cell fusion, classified in class 435, subclass 5.

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 Group XII, claim(s) 9 and 15, drawn to a method for inhibiting Epstein-Barr virus cell fusion, classified in class 435, subclass 5.

The inventions are distinct, each from the other because of the following reasons:

Unrelated Inventions

Inventions I-VI are all unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (M.P.E.P. § 806.04 and § 808.01). In the instant case, each group is directed toward a structurally and functionally different polypeptide. Separate searches will also be required for each invention. Accordingly, each group is clearly directed toward a different inventive concept.

Inventions VII-XII are all unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (M.P.E.P. § 806.04 and § 808.01). In the instant case, each group is directed toward a different methodology that accomplishes different scientific objectives and employs different scientific reagents and protocols. Separate searches will also be required for each invention. Accordingly, each group is clearly directed toward a different inventive concept.

Inventions I/VIII-XII, II/VII,IX-XII, III/VII,VIII,X-XII, IV/VII-IX,X,XII, V/VII-X,XII, and VI/VII-XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (M.P.E.P. § 806.04 and § 808.01). In the instant case, each of the identified

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groups does not require the peptide of interest. Separate searches will also be required for each invention. Accordingly, each group is clearly directed toward a different inventive concept.

Product and Process of Using

Inventions I/VII, II/VIII, III/IX, IV/X, V/XI, and VI/XII, respectively, are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case, the polypeptides can be employed in a number of materially different processes such as the generation of immunological reagents or affinity purification schemes.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter, and require separate searches, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. § 1.143). Applicant is also advised that the claims should be amended to reflect the election, where necessary.

37 C.F.R. § 1.48(b)

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(i).

Claim Rejoinder (M.P.E.P. § 821.04)

Applicants are reminded that a restriction between product and process claims has been set forth *supra*. When applicant elects claims directed to the product, and a product claim is subsequently found to be allowable, withdrawn process claims that depend from or otherwise include **all** the limitations of the allowable product claim will be rejoined in accordance with the provisions of § 821.04 of the M.P.E.P. Process claims that depend from or otherwise include **all** the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 C.F.R. § 1.116 while amendments submitted after allowance are governed by 37 C.F.R. § 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 C.F.R. § 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability as set forth under 35 U.S.C. §s 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See AGuidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer, and 35 U.S.C. § 103(b), 1184 O.G. 86 (March 26, 1996). Additionally, in order to

retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so will result in a loss of the right to rejoinder. Furthermore, note that the prohibition against double patenting rejections of 35 U.S.C. § 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See M.P.E.P. § 804.01.

Correspondence

Any inquiry concerning this communication should be directed to Jeffrey S. Parkin, Ph.D., whose telephone number is (571) 272-0908. The examiner can normally be reached Monday through Thursday from 10:30 AM to 9:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Bruce R. Campell, Ph.D., can be reached at (571) 272-0974. Direct general status inquiries to the Technology Center 1600 receptionist at (571) 272-1600. Informal communications may be submitted to the Examiner's RightFAX account at (571) 273-0908.

Applicants are reminded that the United States Patent and Office (Office) requires most patent correspondence to be: a) faxed to the Central FAX number (571-273-8300) (updated as of July 15, 2005), b) hand carried or delivered to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), c) mailed to the mailing address set forth in 37 C.F.R. § 1.1 (e.g., P.O. Box 1450, Alexandria, VA 22313-1450), or d) transmitted to the Office using the Office's Electronic Filing System. This notice replaces all prior Office notices specifying a specific fax number or hand carry address for certain patent related correspondence. further information refer to the Updated Notice of Centralized Delivery and Facsimile Transmission Policy for Patent Related Correspondence, and Exceptions Thereto, 1292 Off. Gaz. Pat. Office 186 (March 29, 2005).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

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http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully,

Jeffrey S. Parkin, Ph.D.

Primary Examiner Art Unit 1648

21 September, 2006